UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,084	05/22/2001	Phillip Andrew Seder	P0377	1802

23735	7590	12/21/2004	

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER
LEMMA, SAMSON B

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/864,084	SEDER ET AL.
	Examiner	Art Unit	
	Samson B Lemma	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 May 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-38_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-38_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _22 May 2004_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 1-38** have been examined.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.   **Claims 1-11; 13-14; 16-18; 20-32; 34-38** are provisionally rejected under the

judicially created doctrine of obviousness-type double patenting as being unpatentable

over claims 1-38 of the copending Application No. 09/853835 (hereinafter refereed as

'835 application). Although the conflicting claims are not identical, they are not

patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

- **As per claim 1** of the instant application, claim 1 of the '835 application

    recite similar method of regulating access to a website by a user terminal via the

    internet, except claim '835 further recites storing the response information and

    at the central computer, verifying authority to access the website based at least

    in part on a comparison of the verification information and the stored response

information. Furthermore all elements/limitation of claim 1 of the instant

application is recited in the claim 1 of the '835 application.

- **As per claims 10 and 20** of the instant application, claim 14 of the '835

application recite similar method of authenticating permission to access to a

system, except claim '835 further recites querying a data structure to determine

whether the verification key is authorized. Furthermore all elements/limitation

of claims 10 and 20 of the instant application is recited in the claim 1 of the '835

application.

- **As per claim 24, 31 and 38** of the instant application, and claims 22

and 26 of the '835 application recite similar method of exchanging data except

claims 24, 31 and 38 of the instant application instead of generating a number

at the central server and storing the number and extracted watermark identifier

in the database as response information, It recites generating a validation key

and encode the validation key and communicate it to the user terminal.

All the rest of the elements/limitation of claims 10 and 20 of the instant

application is recited in the claim 22 of the '835 application.

In further regards

- **Claims 2 and 16** of the instant application and claim 2 of the '835

application further recites similar limitation of identifying data comprising a

document identifier.

- **Claims 3, 23, 25 and 32** of the instant application recites similar limitation

of claim 3 of the '835 application.

- **Claims 4, 9, 21, 26 30 and 34** of the instant application recites similar

limitation of claims 4-7 and 13,17-18 and 31 of the '835 application.

- **Claims 5-8,27-29 and 36** of the instant application recites similar limitation of claim 12 of the '835 application.

- **Claims 11** of the instant application recites similar limitation of claim 1 of the '835 application.

- **Claims 13-14** of the instant application recites similar limitation of claims 7-8 and 11 of the '835 application.

- **Claims 17-18** of the instant application recites similar limitation of claims 8 and 10 of the '835 application.

- **Claims 22** of the instant application recites similar limitation of claim 14 of the '835 application.

- **Claims 35 and 37** of the instant application recites similar limitation of claim 20 of the '835 application.

Specification

4.   The disclosure is objected because of the following informalities:

- On page 16, starting from the last line up to page 17 first Paragraph, the following has been mentioned. "If the validation key is stored in the database (or has been received within a predetermined period), access to the website is denied (step S84). Otherwise access to the website is allowed (S86) ". It should have been written as "If the validation key is not stored in the database (or has not been received within a predetermined period), access to the website is denied (step S84). Otherwise access to the website is allowed (S86) ".

Appropriate correction is required.

Drawings

5.   The drawing is objected because of the following informalities:

*   On page 9, reference [0039], "connection 24 " has been mentioned with

respect to figure 1, however there is no reference on the corresponding figure 1

which indicate "connection 24".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent granted
on an application for patent by another filed in the United States before the invention by the applicant
for patent, except that an international application filed under the treaty defined in section 351(a) shall
have the effects for purposes of this subsection of an application filed in the United States only if the
international application designated the United States and was published under Article 21(2) of such
treaty in the English language.

7.   **Claims 1-38** are rejected under 35 U.S.C. 102(e) as being anticipated by

Philyaw (hereinafter refereed to as **Philyaw**) (U.S. Patent No. 6,631,404).

8.   **As per claim 1 Philyaw** discloses a method for a method of regulating

access to a website by a user terminal via the internet, (Figure 16 and figure

25)

- The user terminal reading a document including an embedded digital watermark, (column 27, lines 18-23) said method comprising the steps of:

- At the user terminal, extracting identifying data from the digital watermark, (column 26, lines 58-column 27, line 2; column 27, lines 18-23) and

- Providing the identifying data to a central computer; (Column 28, lines 11-23; figure 25, ref. Num "2510") (Central computer is met, reference computer "2510" which is shown on figure 25, ref. Num "2510")

    At the central computer:

- Identifying a pointer associated with the identifying data; (Column 28, lines 35-39; column 28, lines 39-63)

- Generating a validation key; and providing the pointer and the validation key to the user terminal; (Column 28, lines 64-67; column 29, lines 1-18)

    At the user terminal,

- Communicating with the website via the pointer and providing the validation key to the website; (Column 30, lines 14-30; figure 25, ref. Num "2516") (website is met, target location "2516") and

    At the website,

- Regulating access to the website by the user terminal based at least in part on the validation key.(Column 30, lines 66- column 31, line 5)

9.   **As per claim 10 and 20 Philyaw** discloses a method of authenticating

permission to access a system comprising the step of:

- Receiving a request to enter the system, the request including at least a

  validation key; (Column 30, lines 66-column 31, lines 5; Column 31, lines 5-39)

- Determining whether the validation key is valid; and allowing access to

  the system based on a determination of said determining step. (Column 30, lines

  66-column 31, lines 5; Column 31, lines 5-39)

10.   **As per claim 24, 31 and 38 Philyaw** discloses a system for exchanging data

comprising:

- A central server comprising at least one database including pointer

  information, (Figure 25, ref. Num "2510"; figure 25, ref. Num "2512";) (Central

  computer or central server is met the "reference computer" shown on figure 25,

  ref. Num "2510" and the database is met the database or "DB" shown on figure

  25, ref. Num "2512") wherein

- When a user terminal communicates an extracted watermark

    identifier to said central server, said central server identifies a

    corresponding pointer associated with the extracted watermark

    identifier, (Column 28, lines 35-39; column 28, lines 39-63; column

    27, lines 18-23; column 28, lines 11-23; figure 25, ref. Num "2510")

    and wherein

- Said central server generates a validation key and encodes the

    validation key, and wherein said central server appends the

    validation key to the corresponding pointer, and communicates the

    pointer and validation key to the user terminal.(Column 30, lines 8-

    19; column 32, lines 66-column 33, line 5)

11.   **As per claim 2 and 16** Philyaw discloses the method as applied to claims 1 and

10 above. Furthermore **Philyaw** discloses the method wherein the identifying data

comprises a document identifier. (column 27, lines 18-23; column 25, lines 19-29)

12.   **As per claims 3, 25 and 32-33**, Philyaw discloses the method as applied to

claims 2, 24 and claim 31 above. Furthermore **Philyaw** discloses the method wherein

the pointer comprises at least one of a URL, IP address and web address. (Column 28,

lines 59-63; column 32, lines 65-67)

13.   **As per claims 4, 11 and 26**, Philyaw discloses the method as applied to claims

2, 10 and 25 above. Furthermore **Philyaw** discloses the method wherein the

validation key comprises a date-time value. (Column 30, lines 55-61)

14.   **As per claims 5-8 and 27-29**, Philyaw discloses the method as applied to

claims 2 and 24 above. Furthermore Philyaw discloses the method further

comprising the step of encoding the validation key wherein the encoding

comprises at least one of hashing, encrypting, and rotating. (Column 30, lines

10-14)

15.   **As per claims 9, 21, 30 and 34**, Philyaw discloses the method as applied to

claims 1, 20, 24 and 32 above. Furthermore **Philyaw** discloses the method

wherein the validation key comprises at least one of a time stamp, a

predetermined number, and a pseudo-random number.(Column 30, lines 55-61)

16.   **As per claim 12**, **Philyaw** discloses the method as applied to claim 10 above.

Furthermore **Philyaw** discloses the method further comprising the step of

decoding the validation key. (column 30, lines 17-19)

17.   **As per claims 13-15**, **Philyaw** discloses the method as applied to claim 10

above. Furthermore **Philyaw** discloses the method wherein the validation key

comprises a timestamp, and said determining step determines whether the

timestamp is stale. (column 30, lines 55-61;column 33, lines 1-16)

18.   **As per claims 17-18**, **Philyaw** discloses the method as applied to claim 10

above. Furthermore **Philyaw** discloses the method further comprising a step of

determining whether the validation key comprises a valid value.(Column 33, lines 1-15)

19.   **As per claims 19 and 23**, **Philyaw** discloses the method as applied to claim 10

and claim 21 above. Furthermore **Philyaw** discloses the method wherein the request

includes a URL and the validation key is appended to the URL. (Column 32, lines 66-

column 33, line 5)

20.   **As per claim 22**, **Philyaw** discloses the method as applied to claim 21 above.

Furthermore **Philyaw** discloses the method wherein said determining step comprises

the steps of querying a database to determine if the validation key is stored

therein.(column 29, line 58- column 30, line 5)

21.   **As per claims 35 and 37**, **Philyaw** discloses the method as applied to claim 34

above. Furthermore **Philyaw** discloses the method wherein said document

identifier comprises an identifier extracted from a digitally watermarked

document. (column 27, lines 18-23; column 25, lines 19-29)

22.   **As per claims 36**, **Philyaw** discloses the method as applied to claim 35 above.

Furthermore **Philyaw** discloses the method further comprising the step of

encoding the validation key (Column 30, lines 10-14)

Conclusion

23.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.(See PTO-Form 892).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Samson B Lemma whose telephone number is 571-272-

3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799.

The fax phone number for the organization where this application or proceeding is
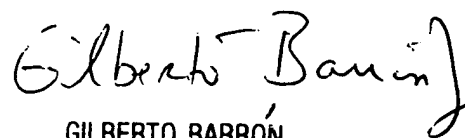
assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S.L

12/08/2004

GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100